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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,182	11/13/2003	Merrill Brooks Smith	64243.000018	7887
27682	7590	08/24/2005		
J. MICHAEL MARTINEZ DE ANDINO ESQ. HUNTON & WILLIAMS RIVERFRONT PLAZA, EAST TOWER 951 EAST BYRD ST. RICHMOND, VA 23219-4074				
			EXAMINER TRAIL, ALLYSON NEEL	
			ART UNIT 2876	PAPER NUMBER
DATE MAILED: 08/24/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/712,182

Applicant(s)

SMITH, MERRILL BROOKS

Examiner

Allyson N. Trail

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/9/2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9-11,13-19,21-36,38-45 and 52-58 is/are rejected.
- 7) ☒ Claim(s) 2, 8, 12, 20, 37, and 46-51 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11-2004, 1-2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment

1. Receipt is acknowledged of the Amendment filed June 9, 2005.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3, 4, 9, 10, 13-16, 21-36, 38-45, and 52-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Tami et al (2004/0049427).

Tami et al teaches the following in regards to claims 1, 9, 10, 14, 34, and 38:

"A method of interaction between a customer and a point-of-sale system for a retail store." (Abstract).

Tami et al teaches an "Express Customer Card", which is presented at the point-of-sale. The customer card is scanned (or the number key entered if unable to scan) and the Customer record is retrieved from the Host 12. The POS terminal prompts for the Customer Card to be scanned/entered as the first step in a new transaction. Once the number is entered and accepted, the customer is then entitled to take advantage of the Express Savings 21 and Express Points 22 programs. The Express Savings 21 and

Express Points 22 programs include the ability to receive discount prices as soon as the card is accepted. (Paragraph 0461).

The keycard is associated with a specific provider (the store) and a specific value (the discounted purchase price).

Tami et al teaches the following in regards to claims 3, 13, 15, 21, 35:

Each Express Customer Card is specifically associated with a customer.

Therefore the confirmation includes a PIN used only with the one specific customer.

Tami et al teaches the following in regards to claim 39:

The keycard is retained by the merchant after the product is delivered.
(Paragraph 0526).

Although each Tami does not specifically teach all the various products that are associated with the keycard i.e., what products result in a discounted or new price due to the use of the keycard, Tami et al teaches that the keycard is used to receive discounted prices on any item in the store and therefore teaches the keycard providing a set new price on calling cards (claims 4, 16, 32), stored-value cards (claims 22 and 36), gift cards (claim 23), pre-paid gas, grocery, or entertainment cards (claims 24-26), downloadable ring tone, game, or music cards (claims 27-30), rewards cards (claim 31), downloading software (claim 33) or any of the other products or services in regards to claims 40-45 and 52-58.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5-7 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tami et al (2004/0049427) in view of Goldstein et al (2004/0069845).

Tami et al's teachings are discussed above. Tami et al however fails to specifically teach the keycard including a barcode and a magnetic stripe.

Goldstein et al teaches the following in regards to claims 5-7 and 17-19:

Transaction cards, such as customer loyalty cards are commonly manufactured using encoding and printing apparatus. For example, many types of transaction cards must be personalized, i.e., encoded, printed, or otherwise processed so that each card in a given group of cards is uniquely identified from other cards in the group. For example, transaction cards in a loyalty card program may be encoded and/or printed to carry a unique identifier such as an alpha numeric string encoded in a magnetic stripe on the card and/or printed as a barcode on the card. This unique identifier allows each card in a group of cards to be uniquely identified with a particular issuee so that future transactions made with the card can later be associated with the issuee." (Paragraph 0003).

In view of Goldstein et al's teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a barcode and a magnetic stripe on the keycard taught by Tami et al. Tami et al teaches above scanning the keycard to obtain customer information. Although it is not specifically stated, scanning of a card usually relates to scanning a barcode on a card. Additionally,

including a magnetic stripe on the keycard is another common method in the art to provide stored information on a card. One would be motivated to use either a barcode or magnetic stripe on the keycard taught by Tami et al in order to store customer or keycard information so that the information may be easily accessed.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tami et al (2004/0049427) in view of Dev et al (2004/0054587).

Tami et al's teachings are discussed above. Tami et al however fails to specifically teach the keycard being affixed to a device.

Dev et al teaches the following in regards to claim 11:

Loyalty or customer cards are carried on customer's key chains. (Paragraph 0007).

In view of Dev et al's teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to affix the plurality of keycards such as the keycard taught by Tami et al on a single device as taught by Dev et al. One would be motivated to keep all of the keycards together in order for the customer to quickly and easily locate the desired keycard.

Allowable Subject Matter

7. Claims 2, 8, 12, 20, 37, and 46-51 are objected to as being dependent upon a rejected base claim and also objected to above, but would be allowable if rewritten in independent form and overcoming the above objection, including all of the limitations of the base claim and any intervening claims.

The following is an examiner's for allowance: Tami et al teaches a method for automating a transaction request including selecting a keycard from among multiple keycards, the above identified prior art of record, taken alone, or in combination with any other prior art, fails to teach or fairly suggest the specific features of claims 2, 8 of the present claimed invention. Prior art fails to teach associating the keycard with a specific provider, a specific value, and a specific transaction type, and wherein the transaction type comprises activating a stored-value account, adding value to a stored-value account, or transferring value from a stored-value account. Prior art additionally fails to teach associating the keycard with a specific telecommunications service provider and a specific value, wherein at least one of the plurality of keycards is associated with a provider which is different from the provider associated with the selected keycard, and wherein at least one of the plurality of keycards is associated with a different value than the selected keycard. Prior art fails to teach a customer selecting a dummy card and a merchant selecting a keycard associated with the dummy card. Lastly, prior art fails wherein the indicia has an associated stored value, further including, receiving a request from a customer to add the associated stored value to a customer account, wherein the customer account is managed by a provider of the product or service. Moreover, one of ordinary skill in the art would not have been motivated to come to the claimed invention.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

8. Applicant's arguments, see pages 1-6, filed June 9, 2005, have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Tami et al. It is believed that Tami et al's teachings above include selecting a keycard (Express Customer Card) from among multiple keycards. It is known that each store includes its own keycard (customer card) and therefore depending on which store the customer is in, the customer chooses between a plurality of keycards. The customer card information is input at a merchant terminal and transmitted from the merchant terminal to a central processor. The central processor confirms the transaction, wherein the transaction confirmation is associated with the product identification number.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Allyson N. Trail* whose telephone number is (571) 272-2406. The examiner can normally be reached between the hours of 7:30AM to 4:00PM Monday thru Friday.

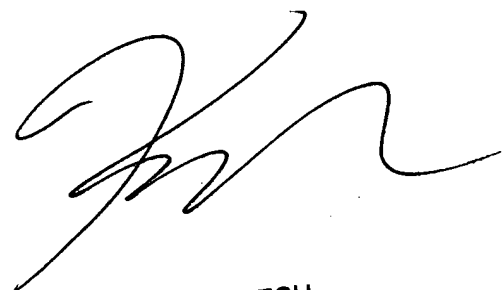
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571) 272-2398. The fax phone number for this Group is (571) 273-8300.

Art Unit: 2876

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [allyson.trail@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Allyson N. Trail
Patent Examiner
Art Unit 2876
August 22, 2005

A handwritten signature in black ink, appearing to read 'Karl D. Frech', is written over a rectangular stamp.

KARL D. FRECH
PRIMARY EXAMINER

REPLACEMENT SHEET

Figure 2

